

REMARKS

A. Rejection of claims 1-15 under 35 U.S.C §103

5 Claims 1 and 5-15

On page 2 of the Office Action, the Examiner has rejected claims 1 and 5-15 under 35 U.S.C. §103 as being unpatentable over U. S. Patent No. 6,687,878 (hereinafter referred to as Eintracht et al.) in view of United States Patent No. 10 6,092,074 (hereinafter referred to as Rodkin et al.). The Applicant respectfully traverses this rejection and submits that claims 1 and 5-15 are in allowable form.

In order for the Examiner to establish a prima facie case of obviousness, it is well known that three criteria must be satisfied: **(1) there must be some**
15 **suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings,** (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all of the claim limitations. MPEP §§ 706.02(j), 2142 (8th
20 ed.).

MPEP § 2142 (8th ed.) states as follows:

25 *The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been*
30 *obvious in light of the teachings of the references."*

Furthermore, in *In re Geiger*¹, the Federal Circuit held that "[o]bviousness cannot be established by combining teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination".

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Eintracht et al. describes a system for document annotation based on the exchange of notes attached to web based documents. A notes server is provided on a server side to log all annotation activities, and a plug-in module is provided on a client side, which contains the user interface for navigating within the document and for handling annotations.

As the Examiner has acknowledged, "Eintracht et al do not explicitly teach manipulating HTML" as described in independent claim 1. The Examiner has relied on Rodkin et al. to provide this limitation, stating that "it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Eintracht et al. with that of Rodkin et al. because such a combination would provide the users of Eintracht wet [sic] al. the benefit of a *method and apparatus for automatically providing hypertext anchor codes and destination addresses for a user-readable text file at a content server*".

The Applicant respectfully submits that the Examiner has erred in this assertion.

The hypertext markup language, or HTML, is readable by any commercially available Internet browser. Conversely, as stated in Eintracht et al. at column 1, lines 23-26, "special data formats, e.g., video, certain images, *documents not written in HTML language, etc.*, are treated by one or more web browser software plug-ins". Eintracht et al. relies solely on the use of non-HTML software plug-ins instead of the HTML language to enable document annotation. Were the document annotation system taught by Eintracht et al. feasible in HTML, it would not require additional software plug-ins. This however is not the case, and, as such, one of ordinary skill in the art would find no benefit in combining the invention of Eintracht et al. with another describing the manipulation of HTML.

As such, the Applicant respectfully submits that there exists no motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the non-HTML document annotation system taught in Eintracht et al. with the method and apparatus for automatically

¹ 815 F.2d 686, 690, 2 USPQ2d, 1276, 1279 (Fed. Cir. 1987)

providing hypertext anchor codes taught in Rodkin et al.

In light of the foregoing discussion, the Applicant respectfully submits that at least one of the criteria required to establish a prima facie case of obviousness
5 have not been met, and the Examiner is respectfully requested to withdraw the rejection of claims 1 and 5-15 under 35 U.S.C. §103.

Claims 2 and 16-18

10 On page 6 of the Office Action, the Examiner has rejected claims 2 and 16-18 under 35 U.S.C. §103 as being unpatentable over Eintracht et al. in view of Rodkin et al. and in further view of United States Patent No. 6,573,907 (hereinafter referred to as Madrane). For the same reasons as detailed above, the Applicant respectfully submits that there exists no motivation, either in the
15 references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine Eintracht et al. with Rodkin et al. For its part, Madrane teaches that Microsoft's DHTML editor is a preferred HTML editor, but fails to provide any motivation to combine the non-HTML document annotation system taught in Eintracht et al. with the method and apparatus for automatically
20 providing hypertext anchor codes taught in Rodkin et al. As such, the Applicant respectfully submits that claims 2 and 16-18 are in allowable form and requests that the Examiner withdraw the rejection of claims 2 and 16-18 under 35 U.S.C. §103.

25 Claims 3 and 4

On page 8 of the Office Action, the Examiner has rejected claims 3 and 4 under 35 U.S.C. §103 as being unpatentable over Eintracht et al. in view of Rodkin et al. and in further view of United States Patent No. 5,577,188 (hereinafter
30 referred to as Zhu). For the same reasons as detailed above, the Applicant respectfully submits that there exists no motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine Eintracht et al. with Rodkin et al. For its part, Zhu describes a pen tool, a highlight tool and a notes tool, but fails to provide any motivation to

combine the non-HTML document annotation system taught in Eintracht et al. with the method and apparatus for automatically providing hypertext anchor codes taught in Rodkin et al. As such, the Applicant respectfully submits that claims 3 and 4 are in allowable form and requests that the Examiner withdraw
5 the rejection of claims 3 and 4 under 35 U.S.C. §103.

Claim 19-22

On page 9 of the Office Action, the Examiner has rejected claims 19-22 under 35
10 U.S.C. §103 as being unpatentable over Eintracht et al. in view of Madrane.

The Examiner has acknowledged that "Eintracht et al. do not explicitly teach DHTML", as described in claim 19. In a manner similar to that discussed above, the Examiner has relied on Madrane to provide the missing limitation, stating that
15 "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Eintracht et al. with that of Madrane because such a combination would allow the users of Eintracht et al. the benefit of a [sic] *managing media files, creating and authoring media containers, publishing and indexing media containers, searching and browsing media*
20 *containers, and distributing media containers*".

Here again, the Applicant respectfully submits that the Examiner has erred in this assertion.

25 Dynamic HTML, or DHTML, is a collective term for a combination of new Hypertext Markup Language (HTML) tags and options, that will let you create Web pages more animated and more responsive to user interaction than previous versions of HTML². Therefore, for precisely the same reasons as outlined above with regard to claim 1 and 5-15, one of ordinary skill in the would find no benefit
30 in combining the invention of Eintracht et al. with another describing the manipulation of DHTML.

² dynamic HTML – a Whatis.com definition,

As such, the Applicant respectfully submits that there exists no motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the non-HTML document annotation system taught in Eintracht et al. with the invention taught by Madrane.

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In light of the foregoing discussion, the Applicant respectfully submits that at least one of the criteria required to establish a prima facie case of obviousness have not been met, such that the Examiner is requested to withdraw the rejection of claims 19-22 under 35 U.S.C. §103.

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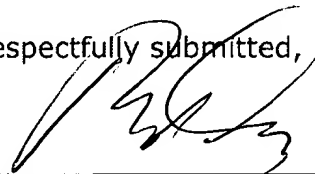
The Applicant believes the subject matter of claims 1-22 is novel and non-obvious over the cited prior art references, and as such, in condition for allowance.

CONCLUSION

In view of the foregoing, the Applicants are of the view that claims 1-22 are in allowable form. Favorable reconsideration is requested. Early allowance of the
5 Application is earnestly solicited.

If the application is not considered to be in full condition for allowance, for any reason, the Applicants respectfully request the constructive assistance and suggestions of the Examiner in drafting one or more acceptable claims pursuant
10 to MPEP 707.07(j) or in making constructive suggestions pursuant to MPEP 706.03 so that the application can be placed in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,



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